

REMARKS/ARGUMENTS

In view of the foregoing amendments and the following remarks, the applicants respectfully submit that the pending claims comply with 35 U.S.C. § 112, are not anticipated under 35 U.S.C. § 102 and are not rendered obvious under 35 U.S.C. § 103. Accordingly, it is believed that this application is in condition for allowance. If, however, the Examiner believes that there are any unresolved issues, or believes that some or all of the claims are not in condition for allowance, the applicants respectfully request that the Examiner contact the undersigned to schedule a telephone Examiner Interview before any further actions on the merits.

The applicants will now address each of the issues raised in the outstanding Office Action. Before doing so, however, the undersigned would like to thank Primary Examiner Rimell for courtesies extended during a telephone interview on August 8, 2006 ("the telephone interview"). During the telephone interview, the present invention was discussed, and the Merriman patent was discussed with respect to claims 1, 7 and 13.

Rejections under 35 U.S.C. § 112

Claims 29, 30, 70 and 71 are rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention. The previous Examiner contended that in these claims, it is not clear as to what request is being submitted before the rendering of the document content.

The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the clarifying amendments to claims 29, 30, 70 and 71.

Claims 34 and 75 are rejected under 35 U.S.C. § 112, second paragraph, as failing to set forth the subject matter which applicants regard as their invention. The previous Examiner contended that the use of the term "substantially" renders these claims invalid. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the clarifying amendments to claims 34 and 75.

Rejections under 35 U.S.C. § 102

Claims 1-19, 23-32, 35-38, 42-60, 64-73 and 76-79 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,948,061 ("the Merriman patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

During the telephone interview, Examiner Rimell indicated that he did not agree with all aspects of the previous Examiner's Office Action, and he felt that dependent claim 7 and independent claim 13 were allowable over the Merriman patent. Apparatus claims 48 and 54 correspond to method claims 7 and 13, respectively, and are therefore similarly allowable over the Merriman patent. Further, since claims 14-19, 23-32 and 35-38 depend, either directly or indirectly, from claim 13, and since claims 55-60, 64-73 and 76-79 depend, either directly or indirectly, from claim 54, these claims are similarly patentable over the Merriman patent.

Regarding independent 1, however, Examiner Rimell indicated that he felt that the Merriman patent anticipated claim 1 because the message 23 generated by the client device (instead of the page loaded into the client device) can be characterized as the claimed document. Examiner Rimell contrasted this with act (a) of claim 13 in which the document is received by the client device.

Claim 1 has been amended to recite a method for use in an environment including a client device and an ad server, the method comprising (a) accepting information concerning a *document requested by the client device*, the information being sourced from an application on the client device, (b) determining at least one ad relevant to content of the document using at least the accepted information, and (c) sending the at least one ad determined to the client device. Claim 1, as amended, precludes the characterization of the message 23 generated by the client device in the Merriman patent as the claimed document. Thus, independent claim 1 is not anticipated by the Merriman patent for at least this reason. Since apparatus claim 42 has been similarly amended, it is similarly not anticipated by the Merriman patent.

Since claims 2-12 depend, either directly or indirectly, from claim 1, and since claims 43-53 depend, either directly or indirectly, from claim 42, these claims are similarly not anticipated by the Merriman patent.

Rejections under 35 U.S.C. § 103

Claims 20-22 and 61-63 are rejected under 35 U.S.C. § 103(a) as being unpatentable the Merriman patent. The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The previous Examiner conceded that the Merriman patent does not show the rendering location of an ad window relative to the content of a document, such as Web page window location. (See Paper No. 20050722, page 7.) To compensate for this deficiency, the previous Examiner argued that it would have been obvious to one of ordinary skill in the art at the time of the invention to render any window in any location. Even assuming, arguendo, that this is true, this does not compensate for the deficiencies of the Merriman patent with respect to claims 13 and 54 acknowledged by Examiner Rimell during the telephone interview. Consequently, these claims are not rendered obvious by the Merriman patent. Thus, the applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Claims 33, 34, 39-41, 74, 75 and 80-82 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the Merriman patent in view of U.S. Patent No. 6,892,354 ("the Servan-Schreiber patent"). The applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection in view of the following.

The previous Examiner conceded that the Merriman patent does not teach that the act of submitting a

request for at least one content-relevant ad to the content-relevant ad server occurs before a request for the requested document. (See Paper No. 20050722, page 8.) In an effort to compensate for this admitted deficiency of the Merriman patent, the previous Examiner cited column 3, line 56-67 of the Servan-Schreiber patent as teaching submitting an ad request before a request for a document. The previous Examiner concluded that it would have been obvious to submit a request for ads before the document request in the Merriman patent because doing so would keep the user interested in the document or Website while the Website is downloading. (See Paper No. 20050722, page 9.)

First, even assuming, arguendo, that the Servan-Schreiber patent includes the purported teaching, and further assuming, arguendo, that one skilled in the art would have been motivated to combine the references as proposed by the previous Examiner, this combination does not compensate for the deficiencies of the Merriman patent with respect to claims 13 and 54 acknowledged by Examiner Rimell during the telephone interview. Consequently, these claims are not rendered obvious by the Merriman and Servan-Schreiber patents for at least this first reason. Thus, the applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Second, referring to column 3, lines 28-37 of the Merriman patent, since the document of an affiliate includes the link to the ad server, the ad request can not be sent before the document is both requested and received. Thus, the modification proposed by the previous Examiner -- under which an ad request is sent

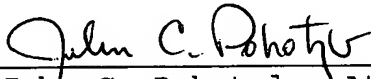
before a document request -- would likely render the Merriman patent inoperable, and one skilled in the art would therefore not have been motivated to combine the references as proposed. Consequently, these claims are not rendered obvious by the Merriman and Servan-Schreiber patents for at least this second reason. Thus, the applicants respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Conclusion

In view of the foregoing amendments and remarks, the applicant respectfully submits that the pending claims are in condition for allowance. Accordingly, the applicants request that the Examiner pass this application to issue.

Respectfully submitted,

August 10, 2006



John C. Pokotylo, Attorney
Reg. No. 36,242
Tel.: (732) 542-9070

CERTIFICATE OF MAILING under 37 C.F.R. 1.8(a)

I hereby certify that this correspondence is being deposited on August 10, 2006 with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



John C. Pokotylo

36,242
Reg. No.